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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,723	04/05/2001	Gabrie Hoogland	08CV05967	6059

7590

03/06/2003

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EXAMINER

BUTTNER, DAVID J

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 03/06/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/826,723

Applicant(s)

HOOGLAND ET AL.

Examiner

David Buttner

Art Unit

1712

The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12 and 13 is/are rejected.
- 7) ☒ Claim(s) 11 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> . | 6) <input type="checkbox"/> Other: |

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Applicant is advised that should claim 8 be found allowable, claim 12 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The two claims appear to be identical.

Claims 1-9, 12 and 13 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Conn 2002/0082360 Publication.

Conn blends polycarbonate with a polyester derived from cyclohexane dimethanol (claim 1) and optionally cyclohexane dicarboxylic acid. The blend can be used in cast films (paragraph 31). Also note the blend can be solution prepared followed by evaporation of the solvent (paragraph 25). The same optical properties must be inherently present for Conn, because Conn uses the same species of polycarbonate and polyester as applicant desires.

Note that "solvent cast" is a product by process limitation (MPEP 2113).

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Claims 1-5, 8, 12 and 13 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Williams 2002/0086953 Publication.

Williams blends polycarbonate with a polyester derived from cyclohexane dimethanol and optionally cyclohexane dicarboxylic acid (claim 1). The blend can be used in cast films (paragraph 34). Also note the blend can be solution prepared followed by evaporation of solvent (paragraph 28). The same optical properties must be inherently present for Williams, because he uses the same species of polycarbonate and polyester as applicant desires.

Claims 1-10, 12 and 13 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Lawrence Patent.

Lawrence exemplifies (example 1) a dye receiving layer of polycarbonate, PCCD, plasticizers and surfactant coated from dichloromethane. This is a "solvent casted film". The ratio of polycarbonate to polyester can be 75:25 to 25:75 (col. 10, lines 32). Presumably, applicant's optical properties are present in the Lawrence film as the same species of PC and polyesters are utilized.

Claims 1-10 and 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Flora '453 Patent.

Flora claims (# 3) films of polycarbonate and a polyester derived from cyclohexane dicarboxylic acid, cyclohexane dimethanol and polyether. Flora does not state the film is formed by solvent casting. The product by process limitation is met by any process that forms the same final product (MPEP 2113).

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Claims 1-10 and 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over the Factor Patent.

Factor exemplifies blends of PC with PCCD (table 1). The blends are formed into plaques. This qualifies as applicant's "substrate". It must have the same optical properties as applicant's composition as the same amounts and species of polymers are used.

Claims 1-10, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Conn or Williams or Flora or Factor References in view of Lawrence or Handa.

Conn/Williams/Flora/Factor do not literally state "solvent casted films" or "solvent casted articles".

This is a well known technique. Lawrence exemplifies (# 1) solvent casting a layer of PC + polyester. Handa (col. 11, line 62; col. 4, lines 56-65) teaches solvent casting optical articles of various transparent plastics as an alternative to extrusion.

It would have been obvious to "solvent cast" the films or other articles of the primary references. Only the expected results are obtained.

Claim 11 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The references of record do not suggest this type of polycarbonate. There is nothing of record to indicate substituting this polycarbonate in place of the common BPA based polycarbonate would still result in transparent polycarbonate/polyester blends.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 703-308-2403. The examiner can normally be reached on Weekdays from 10:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

DAVID J. BUTTNER
PRIMARY EXAMINER

D. Buttner/mn
March 5, 2003

